

### **REMARKS/ARGUMENTS**

Applicant has carefully reviewed and considered the Office Action mailed on June 2, 2009, and the references cited therewith.

Claims 1 and 13 are amended, no claims are canceled, and no claims are added. Claims 1-9, 12-19, and 22 are pending in this application.

Applicant has amended claims 1 and 13 to more clearly recite the claimed subject matter and respectfully submits that none of the amendments herein introduce any new subject matter.

#### **Examiner's Interview Summary**

Applicant thanks Examiner Tyson for conducting a brief interview by phone on July 1, 2009 to discuss the present application with Joe Huebsch and Rob Hagen. Applicant particularly thanks Examiner Tyson for suggesting language that has been incorporated to the currently amended claims. During this interview, the claims and proposed amendments were discussed. There was a helpful dialogue such that Applicant believes the present claims are in patentable order.

#### **§103 Rejection of the Claims**

Claims 1, 4-9, 13-14, and 16-19 were rejected under 35 USC § 103(a) as being unpatentable over Stinson, et al. (U.S. Patent No. 6,340,367) and Case, et al. (U.S. Publication No. 2004/0167619). Applicant has amended independent claims 1 and 13 to more clearly recite the claimed subject matter. Insofar as the rejection applies to the amended claim, Applicant respectfully traverses the rejection as follows.

From Applicant's review, the Stinson reference does not teach or suggest each and every element as provided in Applicant's independent claims 1 and 13. Furthermore, the Case reference does not appear to cure the deficiencies of the Stinson reference.

For example, Stinson and Case, alone or in combination, do not appear to teach or suggest radio frequency (RF) markers that form generally concentric loops on only an outside surface of the first cell and the second cell to respectively delineate an outer circumference of the first cell and an outer circumference of the second cell as provided, in part, in Applicant's claim 1. Further, Stinson and Case, alone or in combination, do not appear to teach or suggest radio frequency (RF) markers located only on an outside of the peripheral surface of the structure that respectively delineate outer circumferences of the two or more cells of the structure to emit sufficient RF energy under MRI visualization to disturb hydrogen atom spins of at least one voxel as provided, in part, in Applicant's claim 13.

In contrast to Applicant's claims, Stinson appears to teach discrete permanent markers that are a coil, knot or a ring around feature of the stent (Column 9, lines 9-11) and Case appears to disclose an endoprosthesis comprising markers which may delineate a peripheral circumference of an aperture of the endoprosthesis (Office Action, page 4).

Additionally, as appreciated, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

The Office Action provides that Stinson discloses RF markers (24) that may form generally concentric loops of conductive material on an outside surface of any of the cells in which imaging is desired (Office Action, page 3) and that Case discloses markers may delineate a peripheral circumference of a cell or aperture of an endoprosthesis (Office Action, page 4). The Office Action provides it would have been obvious to one having ordinary skill in the art at the time the invention was made to form Stinson's markers such that they would delineate the peripheral circumference of the cells as taught by Case (Office Action, page 4).

However, Stinson provides "only small, specific sites are marked by the marker 24 so a minimum amount of foreign body material would be added to the implantable endoprosthesis 16" (Column 14, lines 61-65). For examples of small,

specific sites Stinson provides “the markers 24 may be relatively small and comprise a single loop or pigtail of wire around one filament crossing point, filament, an embolization coil, or the like” (Column 14, lines 45-49).

It appears that modifying Stinson by delineating a cell, as taught by Case, would necessarily increase the foreign body material that would be added to the modified implantable endoprosthesis. It appears that the modification of Stinson that would necessarily increase the foreign material would change the principle of operation of Stinson that is providing a minimum amount of foreign body material to the implantable endoprosthesis. Therefore, it would not have been obvious to form Stinson’s markers such that they would delineate the peripheral circumference of the cells as taught by Case.

Accordingly, based on the forgoing, Applicant respectfully requests reconsideration and withdrawal of the 103 rejection of independent claims 1 and 13 as well as those claims which depend therefrom.

Claims 2-3 and 15 were rejected under 35 USC § 103(a) as being unpatentable over Stinson, et al. (U.S. Patent No. 6,340,367) and Case, et al. (U.S. Publication No. 2004/0167619) as applied to claims 1 and 13 above, and further view of Doran, et al. (U.S. Publication No. 2002/0055770). Applicant respectfully traverses the rejection as follows.

As discussed above, from Applicant’s review, it would not have been obvious to one having ordinary skill in the art to form Stinson’s markers such that they delineate the circumference of the cells as taught by Case. Furthermore, the Doran reference does not appear to cure the deficiencies of the Stinson and Case references.

Based on the forgoing, Applicant respectfully requests reconsideration and withdrawal of the §103 rejection of dependent claims 2-3 which depend from independent claim 1 and dependent claim 15 which depends from independent claim 13.

Claims 12 and 22 were rejected under 35 USC § 103(a) as being unpatentable over Stinson, et al. (U.S. Patent No. 6,340,367) and Case, et al. (U.S. Publication No. 2004/0167619) as applied to claims 1 and 13 above, and further view of Jackson, et al. (U.S. Publication No. 2003/0004563). Applicant respectfully traverses the rejection as follows.

As discussed above, from Applicant's review, it would not have been obvious to one having ordinary skill in the art to form Stinson's markers such that they delineate the circumference of the cells as taught by Case. Furthermore, the Jackson reference does not appear to cure the deficiencies of the Stinson and Case references.

Based on the forgoing, Applicant respectfully requests reconsideration and withdrawal of the §103 rejection of dependent claim 12 which depend from independent claim 1 and dependent claim 22 which depends from independent claim 13.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's below listed attorney at (612) 236-0122 to facilitate prosecution of this matter.

**CERTIFICATE UNDER 37 CFR §1.8:** The undersigned hereby certifies that this correspondence is being filed electronically with the U.S. Patent and Trademark Office on this 20 day of

July, 2009.

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